

REMARKS

The Examiner has rejected claims 6, 8, and 10-11 under 35 U.S.C. § 103(a) as being unpatentable over JP 55-134816 to Sonada (“Sonada”) in view of U.S. Patent No. 5,835,289 to Berry (“Berry”) and U.S. Patent No. 4,720,804 to Moore (“Moore”). Claims 6, 10, and 11 are currently amended. Claims 6, 8, and 10-11 are currently pending. The following remarks are considered by applicant to overcome each of the Examiner's outstanding rejections to current claims 6, 8, and 10-11. An early Notice of Allowance is therefore requested.

I. SUMMARY OF RELEVANT LAW

The determination of obviousness rests on whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. In determining obviousness, four factors should be weighed: (1) the scope and content of the prior art, (2) the differences between the art and the claims at issue, (3) the level of ordinary skill in the art, and (4) whatever objective evidence may be present. Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. The Examiner carries the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness and must show that the references relied on teach or suggest all of the limitations of the claims.

II. REJECTION OF CLAIMS 6, 8, AND 10-11 UNDER 35 U.S.C. § 103(A) BASED ON SONADA IN VIEW OF BERRY AND MOORE

On page 2 of the current Office Action, the Examiner rejects claims 6, 8, and 10-11 under 35 U.S.C. § 103(a) as being unpatentable over Sonada in view of Berry and Moore. This objection is respectfully traversed and believed overcome in view of the following discussion.

Claims 6, 8, and 10-11 differ from Sonada in that, in Sonada, the indicated signs are engraved and are only illuminated from the rear. However, in claims 6, 8, and 10-11, it is mentioned in contrast that the desired indications are represented from an LED display or LCD display (i.e., from a construction element). In fact, the Examiner has admitted that Sonada fails to disclose the claim language stating “wherein a self-illuminating LED display which is connected to control electronics or an LCD display with background illumination which is connected to control electronics is provided in the intermediate image plane of the eyepiece.”

Rather, the Examiner asserts that Moore discloses the above claim language. Moore is directed to a computer controlled image forming apparatus for making quantitative evaluations relating to an image of a subject which is programmed to control a plurality of associated electrically addressable indicia the images of which are viewable superimposed upon the image of the subject. The device is usable for measuring distances, areas, angles, curves, and is controllable by an operator who, by means of first signals input into the computer, selectively addresses particular member of the plurality of indicia by means of second signals output by the computer and conditioned by circuitry in a manner of quantitatively relate the addressed indicia to the image of the subject. Subsequently, the computer interprets the finally addressed indicia in terms of a physical parameter exhibited by the image of the subject for which the computer has been programmed and outputs results of the computations in the form of third signals or display to the operator.

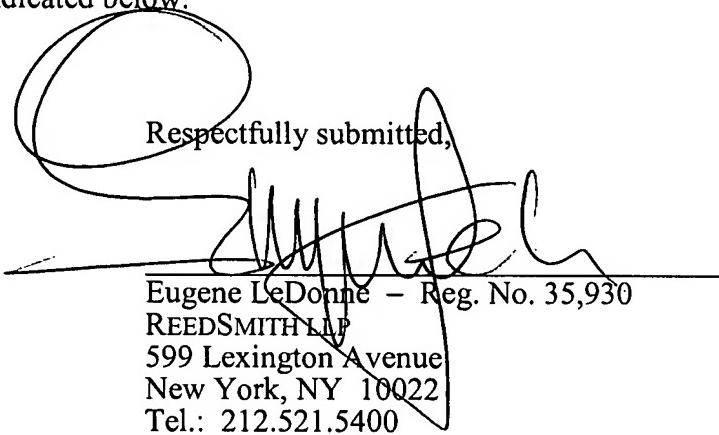
Although Moore discloses the viewing of a sample through the eyepiece whereby the image view can be controlled through a computer, Moore does not provide an area within the eyepiece whereby a viewer can view both the image and information regarding the image within the same eyepiece. This is because, for the invention of Moore to function, (i.e., measure distances, areas, angles, curves), the indicia must be viewable superimposed upon the image of the subject. Accordingly, the invention of Moore mandates that the EL display or LCD display be located inside the image field.

In contrast, the currently claims explicitly state that the LED display or LCD display "is provided in the intermediate image plane of the eyepiece **outside the image field area reserved for observation of the specimen**". ("emphasis added"). Should the teachings of Moore be combined with those of Sonada, the resulting invention would have the EL display or LCD display of Moore located in image viewing area of Sonada (Fig. 2, element 1), and not in the light emitting display means, which is composed of a transparent resin ring 14 (Fig. 2, in place of shielding ring 6). Thus, it is impossible to combine the cited references to arrive at the present invention.

As such, Applicants respectfully assert that Examiner has failed to establish a prima facie case of obviousness of independent claims 6, 8, and 10-11. Therefore, Applicants respectfully request that Examiner remove the rejection of claims 6, 8, and 10-11 under 35 U.S.C. § 103(a) as being unpatentable over JP 55-134816 to Sonada in view of U.S. Patent No. 5,835,289 to Berry and U.S. Patent No. 4,720,804 to Moore.

Based upon the above remarks, Applicant respectfully requests reconsideration of this application and its early allowance. Should the Examiner feel that a telephone conference with Applicant's attorney would expedite the prosecution of this application, the Examiner is urged to contact him at the number indicated below.

Respectfully submitted,



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